

REMARKS

Claims 1, 5 and 6-44 are pending in the present Application, with Claims 6-44 withdrawn from consideration. Claim 1 has been amended, and Claim 45 has been added, leaving Claims 1, 5 and 45 for consideration upon entry of the present Amendment.

Support for the amendment to Claim 1 can be found in the Specification on Page 3, full paragraphs 3-5.

Support for new Claim 45 can be found in the Specification on Page 5, lines 5-7.

No new matter has been introduced by these amendments. Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1 and 5 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 4,880,687 to Yokoyama et al. (hereinafter "Yokoyama"). Applicants respectfully traverse this rejection.

Claim 1 is directed to a coating made of a film formed on the basis of at least one polymer material that includes at least one property-changing component embedded in a matrix of the polymer material, the film comprising several layer-like areas, at least one of the layer-like areas includes the property-changing component, and a concentration of the property-changing component embedded in one of the layer-like areas varies in a direction of a thickness of one of the layer-like areas, wherein the coating is disposed on a workpiece, wherein the workpiece is suitable for application in the food and pharmaceutical industries, environmental protection, connection and drive technology, shipping, fluid energy systems, or the chemical and automobile industries.

Yokoyama is directed to a magnetic recording medium wherein a metal magnetic layer and an overcoat are disposed on a nonmagnetic substrate. The overcoat contains a plasma-polymerized film, and a topcoat containing an organic fluorine compound (Abstract). As clearly

shown in Figures 1-3, the overcoat is not disposed directly on the substrate, but on protective carbon film. The fluorine in the topcoat layer can have a concentration gradient (Col. 16 lines 1-10). The nonmagnetic substrate “generally has a thickness of about 1.2 to about 1.9 mm and a shape of disk or drum” (Col. 12, lines 58-60).

In the Advisory Action, the Examiner refers to the Applicants arguments from the Final Office Action mailed on January 6, 2004, where the Applicants distinguish the present claims from Yokoyama on the basis that the coating is disposed on a workpiece. The Examiner states “applicant’s argument is moot because it is in reference to features that are not claimed”. (Advisory Action, Page 3) Further, “Applicants have also argued that the non-magnetic substrates of Yokoyama are not work pieces as presently claimed because the work pieces referred to in the claims are made of materials known in the mechanical engineering arts is also unpersuasive”. (Advisory Action, Page 3) The Examiner goes on to point out that the non-magnetic substrate of Yokoyama may be made of aluminum or aluminum alloy and states “one of ordinary skill in the mechanical engineering art would recognize aluminum or aluminum alloy as useful material”. (Advisory Action, Page 3) In conclusion, the Examiner states “arguments as to features of an invention that are not claimed cannot be considered to be persuasive”. (Advisory Action, Page 3)

Applicants agree with the Examiner that limitations from the Specification are not read into the claims. The present claims, however, specify that the coating is disposed on a workpiece. Applicants submit that a workpiece as presently claimed is different from the substrate for a magnetic recording medium as described in Yokoyama. While the substrate of Yokoyama and the presently claimed workpieces may be made from similar materials, one of ordinary skill in the art, when reading the Specification as a whole, would understand the difference between the substrate of Yokoyama and a workpiece. A workpiece as described in the Specification is “suitable for application in the food and pharmaceutical industries, environmental protection, connection and drive technology, shipping, fluid energy systems, or the chemical and automobile industries”. Such workpieces are typically made of metal or other base materials as known in the mechanical engineering art. Yokoyama does not disclose a

coating disposed on a workpiece as presently claimed. Instead, Yokoyama describes recording media such as floppy disks and the like. The nonmagnetic substrates of Yokoyama are clearly those suitable for formation of magnetic recording media and are not workpieces as presently claimed.

In order to facilitate prosecution only, Applicants have added Claim 45 to specify the types of workpieces onto which the coating is disposed as “suitable for application in the food and pharmaceutical industries, environmental protection, connection and drive technology, shipping, fluid energy systems, or the chemical and automobile industries”.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Yokoyama does not teach a coating disposed on a workpiece as presently claimed. Yokoyama is specifically directed to magnetic recording media comprising nonmagnetic rigid substrates. Because Yokoyama teaches only substrates suitable for forming magnetic recording media, Yokoyama thus also does not render the coating disposed on a workpiece as presently claimed obvious.

For at least the foregoing reasons, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(b) are requested.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

SWR-0055
09/856,814

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 by Cantor Colburn LLP.

Respectfully submitted,

By: Karen A. LeCuyer

Karen A. LeCuyer

Registration No. 51,928

CANTOR COLBURN LLP

55 Griffin Road South

Bloomfield, CT 06002

Telephone (860) 286-2929

Facsimile (860) 286-0115

Customer No. 23413

April 5, 2004